

Serial No.: 09/780,997

REMARKS

Claims 1-7, 9-12, and 14-22 are pending in the present application after this application adds new claim 22. Claim 21 has been amended to correct typographic errors and/or to further clarify the subject matter recited therein. No new matter is added by the new claim, which finds support throughout the specification and figures, and at least at page 10, line 24 to page 11, line 7. In view of the amendments and the following remarks, favorable reconsideration of this case is respectfully requested.

Claims 1-7, 9-12, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,522,769 to Rhoads et al. (hereinafter referred to as Rhoads), in view of European Patent No. 0651554 A1 to Melnychuck et al. (hereinafter referred to as Melnychuck). Applicants respectfully traverse.

Claim 1 relates to a method of providing a content in which, when a content is transmitted to a user, an electronic watermark for preventing execution of the content is embedded in the content and at least information associated with the user, to whom the content is to be transmitted, is added to the content. The method of claim 1 also includes, when the content is executed, the information associated with the user who has received the content is checked at *both transmitting and receiving ends*, and the execution of the content is allowed by removal of the electronic watermark *if and only if* the result of the checking indicates that the content is an authorized content.

The Examiner admits that Rhoads does not disclose removing a watermark as recited in claim 1. However, the Examiner asserts that Melnychuck discloses this feature by describing a digital image being transmitted to a customer with a watermark that prevents high resolution viewing. (Melnychuck; col. 4, lines 30-48). In Melnychuck, an authorization is required for

Serial No.: 09/780,997

removing the watermark (Melnychuck; col. 5, lines 36-41), and the customer can obtain the authorization in the form of a decryption key or password obtained from the provider of the digital prints (the "professional"). (Melnychuck; col. 4, lines 30-48 and col. 9, lines 20-40). However, the Examiner does not provide any motivation to combine the references other than a restatement of the features of claim 1, stating that "it would have been obvious ... to incorporate the Melnychuck's teaching with Rhoads invention to remove the watermark using the authorization code sent from the server after checking indicates that said content is an authorized content." (Office Action; page 3, lines 12-15). This motivation does not appear to be based on either of the references, and appears to result from improper hindsight. Therefore it is respectfully submitted that the combination of the references is improper.

Additionally, it is respectfully submitted that neither of the references discloses or suggests that, *when content is executed, the information associated with the user who has received the content is checked at both transmitting and receiving ends, and the execution of the content is allowed by removal of the electronic watermark if and only if the result of the checking indicates that the content is an authorized content.* The Specification states that when a user starts an operation to execute a content, it is checked whether a device ID 33 in the header of the content is identical to an actual device ID of a user terminal, etc. If the checking is completed successfully, user name, the password, the device ID and the card ID are transmitted from the user terminal to a content provider 1. Then, the content provider 1 checks the validity of the information by comparing it with information stored in a user database. If it is determined that the received information is valid, the content provider 1 transmits to the user terminal the key information used to remove an electronic watermark from the content (Specification, page 10, line 24 to page 11, line 7).

Serial No.: 09/780,997

The Examiner cites Rhoads at column 11, lines 29-47 as disclosing the feature of when content is executed, the information associated with the user who has received the content is checked at both transmitting and receiving ends, and the execution of the content is allowed by removal of the electronic watermark if and only if the result of the checking indicates that the content is an authorized content. However, Rhoads apparently only discloses copy prevention mechanisms such as a file that can only be copied once, or files that can only be copied onto devices owned by the user. Additionally, Rhoads discusses confirmation of device ownership by an *initial registration process* and supplemented by the user when acquiring new devices, and this ownership information would be encoded into the downloaded music. (Rhoads; col. 11, lines 38-42). However, this portion of Rhoads does not disclose or suggest *a check at a transmitting end* (for instance, the clearinghouse in Rhoads) *when the content is executed* and before the removal of the electronic watermark. Therefore, neither of Rhoads nor Melnychuck's disclose or suggest all of the features of claim 1, and therefore the claim is allowable over the combination of the references, the appropriateness of which is respectfully contested.

For these reasons, Applicants respectfully submit that Rhoads fails to anticipate Applicants' claimed invention as claimed in independent claim 1, and that independent claim 1 is therefore allowable. As independent claims 2-5, 9, 10, 14 and 15 substantially include the limitations of claim 1 pertaining to watermarks, Applicants further submit that independent claims 2-5, 9, 10, 14 and 15 are not anticipated by Rhoads and are in condition for allowance. In addition as claims 6, 7 and 11, 12 respectively depend from allowable independent claims 4, 5 and 9, 10, Applicants further submit that claims 6, 7 and 11, 12 are allowable for at least this reason. In addition as claims 16-18 depend from allowable independent claim 1, claim 19 depends from allowable independent claim 4, and claims 20 and 21 depend from allowable

Serial No.: 09/780,997

independent claim 14, Applicants further submit that these dependent claims are allowable for at least the same reason as their respective base claims are allowable.

Additionally, claim 16 recites that, *when the result of the checking indicates that said content is an authorized content, key information for removal of said electronic watermark is transmitted to the user*. The citation in the rejection is not to a particular cited reference (Rhoads or Melnychuck), and therefore Applicants respectfully request clarification in the next Office Communication. The Applicant assumes for the sake of this response that the citation is to Melnychuck based on the content of the two references. It is submitted that Melnychuck at col. 4, lines 35-45 does not disclose or suggest transmitting to the user key information for removal of said electronic watermark *only* when the result of the checking indicates that said content is an authorized content. Melnychuck appears to disclose transmission of necessary information to a customer *upon payment* to the professional, *without any checking whatsoever*. Therefore, for at least this additional reason claim 16 is allowable.

Similarly, claims 18 and 21 relate to deleting the key information by the user after removal of the electronic watermark. The Office Action admits that neither Rhoads nor Melnychuck disclose or suggest this feature. (Office Action; page 6, lines 10-15). Though the Examiner asserts that it would have been obvious to modify the invention, this misconstrues 35 U.S.C. 103(a), which requires that each and every feature recited in the claims be shown in at least one of the cited references. The obviousness standard may allow the combination of references, but it does not permit a rejection based upon a feature not disclosed in either reference. Therefore, for at least this additional reason claims 18 and 21 are allowable.

New claim 22 depends from independent claim 16 and is therefore allowable for at least the same reason as claim 16 is allowable. Additionally, claim 22 recites that the key information

Serial No.: 09/780,997

for removal of the electronic watermark is transmitted to the user when, first, said information associated with the user who has received said content is checked at the receiving end, and second, a result of the check is communicated by the receiving end to the transmitting end. Finally, in claim 22, as a third step, the transmitting end checks said information associated with the user.. It is respectfully submitted that neither Rhoads nor Melnychuck disclose or suggest this feature.

According to the Specification of this application, before a content provider transmits to a user terminal the key information used to remove an electronic watermark from a content, it is checked whether the user terminal is authentic based on the information in the header of the content. If the user terminal is approved, the information about the user is transmitted to the content provider. Then the content provider checks the validity of the information. If the provider determines that the information is valid, it transmits the key information to the user terminal so that the user can remove the electronic watermark from the content.

Since neither Rhoads nor Melnychuck discloses or suggests the checking performed at a user terminal *before* a content provider transmits to the user terminal the key information, new claim 22 is allowable over the references.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Serial No.: 09/780,997

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,



Brian E. Hennessey
Reg. No. 51,271

CUSTOMER NUMBER 026304

Telephone(212) 940-8800

Fax (212-940-8986

Docket No: 100809-16226 (SCEI 18.303)

BEH:pm